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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,430	06/25/2001	Weng Jen Hwang	BHT-3167-10	6987
7590 09/08/2004 DOUGHERTY & TROXELL SUITE 1404 5205 LEESBURG PIKE FALLS CHURCH, VA 22041			EXAMINER HILLERY, NATHAN	
			ART UNIT 2176	PAPER NUMBER

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

R

Office Action Summary	Application No.	Applicant(s)	
	09/887,430	HWANG, WENG JEN	
	Examiner	Art Unit	
	Nathan Hillery	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Foreign Priority Papers filed on 8/29/01.
2. Claims 1 – 24 are pending in the case. Claims 1, 10, and 15 are independent.

Priority

3. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Objections

6. Claim 10 is objected to because of the following informalities: each claim must be one sentence and end in a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 2 recites the limitation "the Single-Action" in line 2. There is insufficient antecedent basis for this limitation in the claim. Consequently, all subsequent recitations of "the Single-Action" are also rejected.

10. Claim 8 recites the limitation "the data of appendix" in line 4. There is insufficient antecedent basis for this limitation in the claim.

11. Regarding dependent claim 8, it is unclear what Applicant means by **said server will then inquires the correlated information according to said appendix and note record said correlated information into a note record file inside said server by said note record object** specifically the verb **inquires**. Consequently, the Office will interpret the limitation(s) and the claimed invention as whole to the best of its knowledge within the art and in the broadest sense possible.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1 – 5, 7 – 13, 15 – 19, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1).

14. **Regarding independent claim 1**, Eintracht et al. teach that *the notes client comprises a display, network communication means, a processor suitably programmed to run a web browser and a client note plug-in adapted to run within the web browser* (Column 3, lines 40 – 43) and that *the notes information are transmitted between client*

and server applications via TCP/IP protocols over communications means such as a LAN, WAN or the Internet. The invention may be adapted to operate over an Intranet, e.g., LAN, or Extranet, e.g., WAN or the Internet (Column 2, lines 28 – 32), which provide for displaying said web page in a browser of a reader side, wherein said web page is transmitted from a server via the connection of the communication link. Eintracht et al. also teach that *on the client side a client software application functions to display the document that the user wishes to annotate and provides the tools necessary to permit the user to create, edit, retrieve and store notes. Note that the client software application can be implemented as a web browser plug-in module. The plug-in contains the user interface for navigating within the document and for handling the notes (Column 2, lines 33 – 39), which provide for transmitting a note record object to said reader side if said reader wants to note record said contents of said web page, wherein said note record object can write a letter or insert a medium object into various kinds of files; and establishing (or opening) a note record file on said reader side and writing or inserting said selected note recorded contents of said web page into said note record file by said note record object if said reader wants to note record said contents of said web page.* Eintracht does not explicitly teach **selecting the desired note recorded contents of said web page by said reader**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to modify the invention of Eintracht et al. to **select the desired note recorded contents of said web page by said reader**, since Eintracht et al. teach that *upon receipt of the notes buffer, the client updates its locally*

stored Notes Database (step 134) and then displays the contents of the notes buffer in a window within the web browser (step 136) (Column 14, lines 14 – 22). The skilled artisan can easily modify the invention so that the client can select which note(s) to view or edit from the local database and/or buffer that is sent from the server benefiting the client by not overwhelming the client with too many annotations at one time.

15. **Regarding dependent claim 2**, Eintracht et al. teach that *an action field 214 represents the action to be taken on the note. The following values are valid actions. 0 No action 1 Add a note 2 Modify a note 3 Delete a note 4 Add a comment 5 Update status* (Column 17, lines 18 – 28), which provide for **said reader can use the Single-Action to request for note recording, said Single-Action will activate said note record object to establish (or open) said note record file on said reader side and write or insert said selected contents of said web page into said note record file.**

16. **Regarding dependent claim 3**, Eintracht et al. teach that *FIG. 2 is an illustration of an example annotation* (Column 4, line 62), which illustrates that **said note recorded contents of said web page by said reader comprises a letter, a picture object, a voice object, a medium object or a hyperlink object.**

17. **Regarding dependent claim 4**, Eintracht et al. teach that *upon receipt of the notes buffer, the client updates its locally stored Notes Database (step 134) and then displays the contents of the notes buffer in a window within the web browser (step 136). If the user has selected to view the annotations overlying the document, i.e., the image, then the client displays the notes similarly to that shown in FIG. 1B. The user then can process one or more notes, i.e., create new notes, edit existing ones and/or delete one*

*or more notes (step 138) (Column 14, lines 14 – 22), which provide that **the step of transmitting a file operation object to said reader side, wherein said file operation object can produce/ delete any folder or any file on said reader side.***

18. **Regarding dependent claims 5 and 7**, Eintracht et al. teach that *Note Events are exchanged between the server and the clients. Notes Clients forward to the Notes Server requests to view, modify, create or delete notes. In response, the Notes Server Updates the clients with an up to date note list per document. This updating activity is termed Note Synchronization. The synchronization process is performed asynchronously and is always initiated by the Notes Client in response to the user, i.e., it is user driven (Column 9, lines 16 – 24), which provide that **the step of transmitting an asynchronous operation object to said reader side, wherein said asynchronous operation object can asynchronously transmit various kinds of files between said reader side and said server side, and said note recorded contents of said web page, can also be carried out on said server side, said reader can select said desired note recorded contents on said reader side and pass back said selected note recorded contents to said server side, said server will note record said selected note recorded contents passed back into a note record file inside said server by said note record object.***

19. **Regarding dependent claim 8**, Eintracht et al. teach that *the client issues a request to retrieve the notes associated with the image, if there are any, from the server (step 124). The URL that is supplied to the server to retrieve the notes is the same URL that corresponds to the underlying document (image) but having a suffix of*

*.backslash.notes` appended to it. Upon receiving the appended URL, the server searches the Notes Database 60 (FIG. 3) for the specified document using the URL as the key for searching (step 126). Once found, the server filters the notes so as to supply only those notes that the requesting client has permission to view (step 128). The server subsequently serializes the notes after filtering and stores them in a response buffer (step 130). The notes buffer is then sent as a response to the client (step 132). The response buffer data structure is described in more detail hereinbelow (Column 13, line 66 – Column 14, line 13), which provide for **said note recorded contents of said web page, can be carried out on said server side, said note recorded contents of said web page further comprising the data of appendix, and said reader can select an appendix on said reader side and pass back said selected appendix to said server side, and said server will then inquires the correlated information according to said appendix and note record said correlated information into a note record file inside said server by said note record object.***

20. **Regarding dependent claim 9**, Eintracht et al. teach that *if the number of notes is not equal to zero, the client checks the state of the viewing condition flag in the web browser Note Plug-In application. This variable may have the following values; show document only (corresponding to FIG. 1A), show document in addition to notes (corresponding to FIG. 1B), show document and notes in one web browser frame and a list of notes in another web browser frame (corresponding to FIG. 1C)* (Column 14, lines

27 – 33), which provide that **said browser further comprises the program code of said note record object.**

21. **Regarding independent claim 10**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

22. **Regarding dependent claim 11**, the claim incorporates substantially similar subject matter as claim 3, and is rejected along the same rationale.

23. **Regarding dependent claim 12**, the claim incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

24. **Regarding dependent claim 13**, the claim incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

25. **Regarding independent claim 15**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

26. **Regarding dependent claim 16**, the claim incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

27. **Regarding dependent claim 17**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

28. **Regarding dependent claim 18**, the claim incorporates substantially similar subject matter as claim 3, and is rejected along the same rationale.

29. **Regarding dependent claim 19**, Eintracht et al. teach that *when annotations are posted to the server by a client, the state of the annotation database is synchronized such that all other clients can retrieve the current, up to date annotations associated with a document* (Column 2, lines 59 – 62), which provide that **said software program**

comprises the software program of official document process, the software program of trial balance, the software program of database, the software program of e-mail or the software program of presentation.

30. **Regarding dependent claim 21**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

31. **Regarding dependent claim 23**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

32. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) as applied to claims 1 – 5, 7 – 13, 15 – 19, 21, and 23 above, and further in view of Mandri (US 6549751 B1).

33. **Regarding dependent claims 20 and 22**, Eintracht et al. do not explicitly teach **e-books**. However, Mandri does teach that *the student workstations 8 connect to the data storage device 4 through an access control device 6. Each student workstation has a unique access code. When a student wants to download a book from the data storage device 4, the student submits a unique code, specific to the workstation or e-book device. This access code is compared with a stored key and the download is only permitted when there is a match. The instructor's workstation 2 has the ability to access the books stored on the data storage device 4 and to annotate them with hyperlinks to supplementary information* (Column 3, lines 53 – 63), which provide that **said software program comprises the software program of e-books**, and that **said computer readable storage medium comprises the products of CAI**. It would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Mandri with that of Eintracht et al. because such a combination would allow the users of Eintracht et al. the benefit of *a system and method for providing students with a portable electronic textbook which can be connected to network systems* (Column 2, lines 48 – 50).

34. Claims 6, 14, and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) as applied to claims 1 – 5, 7 – 13, 15 – 19, 21, and 23 above, and further in view of Mogul et al. (US 6243761 B1).

35. **Regarding dependent claim 6**, Eintracht et al. do not explicitly teach **medium play**. However, Mogul et al. do teach that *the servers 110 are usually larger computer systems that provide numerous Internet services available to the clients 120. For example, a server can maintain a database (DB) 111 that stores Web pages 112. The pages 112 essentially are content rich data files that encode multimedia information in various formats. For example, the information can be plain text, colored graphic images, moving video, and audio. Typically, the Web pages 112 are designed using the Hyper-Text Mark-up Language (HTML). With HTML, any number of multimedia data files can be specified as inserts for a particular Web page* (Column 5, lines 5 – 15), which provide that **the step of transmitting a medium play object to said reader side, wherein said medium play object can play at least one said medium object on said web page on said reader side**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Mogul et al. with

that of Eintracht et al. because such a combination would allow the users of Eintracht et al. the benefit of *a computer implemented method for automatically adjusting the content of Web pages stored by a server computer connected to a client computer by a network path depending on the effective bandwidth on the network path* (Column 4, lines 1 – 5).

36. **Regarding dependent claim 14**, the claim incorporates substantially similar subject matter as claim 6, and is rejected along the same rationale.

37. **Regarding dependent claim 24**, Eintracht et al. do not explicitly teach **electronic dictionary or the PDA**. However, Mogul et al. do teach that *the clients 120 can be any type of computer, personal computers, workstations, and portable devices, such as a laptop or personal digital assistant (PDA), and the like* (Column 5, lines 18 – 20), which provide that **said computer equipment comprises the electronic dictionary or the PDA**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Mogul et al. with that of Eintracht et al. because such a combination would allow the users of Eintracht et al. the benefit of *a computer implemented method for automatically adjusting the content of Web pages stored by a server computer connected to a client computer by a network path depending on the effective bandwidth on the network path* (Column 4, lines 1 – 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

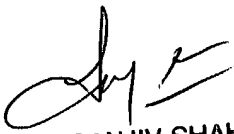
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH


SANJIV SHAH
PRIMARY EXAMINER